

**REMARKS**

This paper is responsive to the Final Office Action dated April 18, 2007 (the “Final Office Action”).

Claims 1-65, 67-228, and 233-236 are pending in the application. The claims have been amended to correct matters of form and to more clearly set forth the claimed subject matter. No claims have been added or canceled in this paper.

Claims 1-57, 77-228, and 233-236 stand rejected. Claim 67 has is under objection. Claims 58-65 and 67-76 have been allowed.

Claim 67 is under objection as depending on a canceled claim. Claims 1-57, 77-228, 233-236 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The above amendments add no new matter. Support for the amendments may be found, for example, on pp. 20-22 of the Specification as originally filed. Applicant respectfully submits that the claims are allowable in view of the amendments and the following remarks.

***Formal Matters***

Applicant is grateful for the indication that claims 58-65 and 67-76 have been allowed. Applicant also expresses gratitude to the Examiner for the discussion between the Examiner and the undersigned representative on March 7, 2007. In that discussion, the Examiner explained that Applicant’s previous Amendment (dated February 9, 2007 and received at the U.S. Patent and Trademark Office on February 14, 2007) had been entered as a response to the Office Action

dated February 13, 2007. The Examiner has revised and reissued the rejections from that Office Action in the present Final Office Action.

***Claim Objection***

Claim 67 is under objection as depending on a canceled claim. Claim 67 has been amended accordingly. Applicant respectfully submits that in view of the amendment, claim 67 is allowable.

***Rejection of Claims under § 101***

Claims 1-57, 77-228, 233-236 stand rejected under § 101 as being directed to non-statutory subject matter. Applicants respectfully submit that the claims are allowable in view of the amendments and remarks presented herein.

**Claims 39-57 and 153-190**

Claims 39-57 and 153-190 stand rejected on pp. 2 and 3 of the Final Office Action under § 101 as being non-statutory subject matter. Applicant understands the arguments in support of these rejections on pp. 2 and 3 of the Office Action as attempting to follow criteria set forth in the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (the “*Guidelines*”) issued October 26, 2005, and available at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf). The *Guidelines* have also been included in § 2106 et. seq. of the *Manual of Patent Examining Procedure* (Ed. 8, Rev. 5, Aug. 2006) (the “MPEP”).

Applicant respectfully submits that an application of the *Guidelines* to Applicant's claims leads to a conclusion that Applicant's claims are patentable under § 101. For example, the Final Office Action cites the following portion from p. 53 the *Guidelines*:

[C]omputer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

(See also, MPEP § 2106.1(I).)

The Final Office Action uses the above passage to conclude on p. 2 that " 'A computer program product encoded in computer readable media' is non-statutory subject matter." Applicant respectfully submits that this conclusion does not follow from the cited portions of the *Guidelines*.

Applicant's claims are allowable under § 101, as can be seen from the subsequent discussion in the Final Office Action, also quoted from p. 53 of the *Guidelines*:

In contrast, a **claimed computer-readable medium encoded with a computer program** is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and **is thus statutory**.

(Emphasis added; See also, MPEP § 2106.1(I).)

In this case, Applicant's independent claim 39 is directed to a computer readable medium, which is among the four categories of inventions indicated in § 101 (processes, machines, manufactures and compositions of matter). The computer readable storage medium

includes instructions executable on a computer system. Independent claim 39 thus sets forth “a claimed computer-readable medium encoded with a computer program,” and is therefore directed to statutory subject matter according to the passages from the *Guidelines* that are reproduced above (and which were cited in the Final Office Action).

Nonetheless, to further clarify the statutory nature of claim 39, Applicant has amended claim 39 to be limited to a computer readable storage medium.

At least for these reasons, Applicant respectfully submits that independent claim 39, and all claims dependent therefrom, are allowable under § 101. At least for similar reasons, Applicant respectfully submits that independent claim 153, and all claims dependent therefrom, are also allowable under § 101.

**Claims 1-57, 77-228, and 233-236**

Claims 1-57, 77-228, and 233-236 stand rejected on p. 3 of the Final Office Action under §101 as having no physical transformation and not producing a useful and tangible result.

Although these criteria regarding a “physical transformation” and “a useful and tangible result” do not explicitly appear in § 101, they are discussed in the *Guidelines* as being relevant in situations where claims touch on a “judicial exception” to patentability under § 101.

Applicant respectfully submits that an application of the *Guidelines* to Applicant’s claims leads to a conclusion that Applicant’s claims are patentable under § 101. For example, in the case of Applicant’s independent claim 1, the claim is directed to a method, and thus falls within one of the four enumerated categories of patentable subject matter recited in § 101 (i.e., process, machine, manufacture, or composition of matter). The method of claim 1 includes a specific

concrete act (generating failure information that includes an indication whether intra-zone resources should be used to restore a virtual path affected by a failure).

The inquiry in the *Guidelines* then turns to judicial exceptions to patentability. The judicial exceptions include claims directed to material such as an abstract idea, natural phenomena, or laws of nature. The *Guidelines* require in MPEP § 2106(IV)(C)(1) that such situations must be dealt with in a specific manner:

USPTO personnel must ascertain the scope of the claim to determine whether it covers either a 35 U.S.C. 101 judicial exception or a practical application of a 35 U.S.C. 101 judicial exception. The conclusion that a particular claim includes a 35 U.S.C. 101 judicial exception does not end the inquiry because the practical application of a judicial exception may qualify for patent protection.

To start, Applicant notes that the Office Action makes no assertion that the system of claim 1 falls within a judicial exception to § 101. Applicant respectfully submits that the system of claim 1 does **not** fall within a judicial exception to § 101, because claim 1 is not directed to an abstract idea, or to a natural phenomenon, or to a law of nature, or to any other judicial exception from patentability. At this stage the inquiry under § 101 is thus concluded, and Applicant's claim 1 qualifies for patent protection under § 101.

Nonetheless, Applicant now proceeds with the analysis of judicial exceptions in order to thoroughly address a point that might be tangentially suggested by the Final Office Action. The *Guidelines* turn in MPEP § 2106(IV)(C)(2) to a follow-up inquiry that is needed for claims that fall within a judicial exception, such as claims that cover laws of nature or abstract ideas. This section addresses situations where a claim includes such judicially excluded subject matter, and sets forth tests to determine if the claims are nonetheless eligible for patent protection. To be

eligible, these tests require that “the claim must be for a *practical application* of the abstract idea, law of nature, or natural phenomenon.” (MPEP § 2106(IV)(C)(2) (emphasis added).)

In the case of Applicant’s claim 1, the follow-up query from MPEP § 2106(IV)(C)(2) is not needed. Since Applicant’s claim 1 is not directed to a § 101 judicial exception, there is no need to check that the exception is remedied by being a practical application of a 35 U.S.C. § 101 judicial exception. Nonetheless, Applicant notes that claim 1 does indeed present a practical application: it is a method that is usable in a specific manner for communicating information regarding a failure that affects a virtual path between a first node and a second node. Thus, even if somehow Applicant’s claim 1 were to be seen as falling within a judicial exception to patentability (a proposition with which Applicant does not agree), the claim would nonetheless be patentable under the *Guidelines* as covering a practical application of the abstract idea, or natural phenomenon, or law of nature, or other judicial exception.

Accordingly, Applicant respectfully submits that independent claim 1 and all claims dependent therefrom are allowable under § 101. At least for similar reasons, Applicant respectfully submits that independent claims 20, 39, 77, 115, 153, and 191 and all claims dependent therefrom are also allowable under § 101.

CONCLUSION

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions, or any other fee associated with this submission, be charged to deposit account 502306.

Applicant submits that the claims are in a condition for allowance, and earnestly solicits a notice to that effect. Should any issues arise that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



2007 June 18

Cyrus F. Bharucha  
Attorney for Applicant  
Reg. No. 42,324  
Telephone: (512) 439-5097  
Facsimile: (512) 439-5099